REMARKS

Claims 39-49 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject application is respectfully requested in view of the comments below.

I. Rejection of Claims 39, 40, and 45-49 Under 35 U.S.C. §103(a)

Claims 39, 40, and 45-49 stand rejected under 35 U.S.C. §103(a) as being obvious over Herrod *et al.* (US 6,405,049) in view of Eberhard *et al.* (US 5,828,322). Withdrawal of this rejection is respectfully requested for at least the following reasons. Herrod *et al.* is not a citable reference for a 35 U.S.C. §103(a) rejection against the subject application.

> "Under a 1999 amendment to 35 U.S.C § 103(c), subject matter which qualifies as prior art only under section 102(e) cannot preclude patentability under 103 where the subject matter and the claimed invention were, at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person [...] the amendment to section 103(c) only affect patents filed on or after November 29, 1999 effective date. *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d, 1346, 1356 n.2, 66 USPQ2d 1331 (Fed. Cir. 2003)

Herrod *et al.* and the claimed invention are commonly owned, or were subject to an obligation of assignment to Symbol Technologies Inc., at the time of the invention. Accordingly, Herrod *et al.* cannot preclude patentability of the subject invention under a 35 U.S.C. §103(a) rejection.

In addition, the other secondary reference, Eberhard *et al.*, does not make up for the absence of Herrod *et al.*, let alone there being any motivation to combine the references as suggested, other than *via* employment of applicants' specification as a 20/20 hind-sight based road map to achieve the purported combination. Assertions are made in the Office Action that "such modification would make the system more practical and more effective [...]". Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103(a). In essence, the rejection is based on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants'

specification. Such rationale has been condemned by the CAFC. (*See, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, Fed. Cir. 1987).

II. <u>Rejection of Claims 41-44 Under 35 U.S.C. §103(a)</u>

Claims 41-44 stand rejected under 35 U.S.C. §103(a) as being obvious by Herrod *et al.* as modified by Ross *et al.* (US 5,859,628) in view of Eberhard *et al.* As explained above, Herrod *et al.* is not a citable reference against the subject application for a 35 U.S.C. §103(a) rejection, and Ross *et al.* in view of Eberhard *et al.* fail to make up for the absence of Herrod *et al.*, with respect to the subject claims, and this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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